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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,610	06/06/2002	Julie C. Double	P 0284989	4555
909	7590	04/09/2004	EXAMINER	
PILLSBURY WINTHROP, LLP P.O. BOX 10500 MCLEAN, VA 22102			SCHILLING, RICHARD L	
			ART UNIT	PAPER NUMBER
			1752	
DATE MAILED: 04/09/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

16/049610

Applicant(s)

Double et al

Examiner

R L Schilling

Group Art Unit

1752

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-20 is/are pending in the application.
- ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-20 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☒ All ☐ Some* ☐ None of the:

☒ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. _____

☐ Copies of the certified copies of the priority documents have been received
in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 3
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over European Patent Publication 917964. The European patent publication (see particularly page 3, lines 3-40; page 4, lines 1-11 and lines 34-59; page 6, lines 36-41; page 11, lines 35-44; page 13, lines 5-26; page 15, lines 30-46; page 8, lines 41-51; Figure 5) discloses thermal transfer elements comprising

supports and thermally transferable protective layers comprising polycarbonates with glass transition temperatures greater than 75°C and molecular weights of 5000 to 100,000. If the European patent publication does not anticipate the instant claims, then it would at least be obvious to one skilled in the art to use polycarbonates with molecular weights of the lower end of the molecular weight range disclosed in the European patent publication. The European patent publication also discloses UV absorbers, backing layers and subcoats.

The comparisons in the specification are noted but are unconvincing as to patentability since they are not commensurate in scope with the claimed subject matter. The polyesters used in the Examples are two specific hydroxyl terminated polyester resins while the instant claims include all polyesters with the required glass transition temperatures and molecular weights including polyesters of carbonic acids, i.e. polycarbonates.

2. Claims 1-3, 5, 6, 8-10, 12, 14, 15, 17 and 18 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hashimoto et al. '375. Hashimoto et al. '375 (see particularly column 2, lines 36-55; column 3, line 39 - column 4, line 7; column 9, lines 1-30; column 10, lines 35-68; Example 1) discloses thermal transfer elements comprising supports and thermally transferable

layers comprising polyester with glass transition temperatures greater than 40°C and molecular weights less than 10,000. The instant claims do not exclude pigments or colorants from the polyester transfer layers. In regard to instant claim 6, carbon black of Hashimoto et al. is a UV absorber. If Hashimoto et al. do not anticipate the instant claims, then it would at least be obvious to one skilled in the art to use polyesters in Hashimoto et al. with preferred molecular weights less than 10,000 and glass transition temperatures in the preferred range of about 50 to 80°C. In Example 1, the polyester has a molecular weight of about 10,000 and a glass transition temperature of about 50.

3. Claims 1-10, 12, 14, 15 and 17-18 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Shimomine et al. Shimomine et al. (see particularly column 4, lines 25-68; Example 5) discloses heat transfer elements with supports and heat transferable polyester layers with molecular weights of 5000 to 20,000 and glass transition temperatures of 45 to 80°C. In Example 5, the polyester has a molecular weight of 7000 and a glass transition temperature of 52. In regard to instant claim 6, carbon black absorbs UV radiation. If Shimomine et al. do not anticipate the instant claims, then it would at least be obvious to one skilled in the art to use polyesters with molecular weights at the lower

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end of the disclosed range as in Example 5 and glass transition temperatures above 50°C within the range of 45-80°C disclosed in Shimomine et al.

4. The prior art submitted by applicants has been considered. Hashimoto et al. '502 is cited of interest in the art as being substantially cumulative to Hashimoto et al. '375. Adkins et al. is cited of interest in the art as disclosing thermally transferable layers comprising polyesters. Tanaka et al. (Example 2) is cited of interest in the art as disclosing thermal transfer layers with polyesters. Stito et al. is cited of interest in the art as disclosing thermal transfer elements with thermally transferable protective layers comprising polyesters with molecular weight ranges and glass transition temperature ranges set forth in the instant claims. Applicants's foreign priority date is prior to the filing date of Stito.

5. Any inquiry concerning this communication should be directed to Mr. Schilling at telephone number (571) 272-1335.

RLSchilling:cdc

April 1, 2004

RICHARD L. SCHILLING
PRIMARY EXAMINER
GROUP 4100/1752

